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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,088	12/08/2000	Herbert Herzog	12020-0003	4580

7590

03/20/2002

Clark & Brody  
1750 K Street NW Suite 600  
Washington, DC 20006

EXAMINER
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ANGELL, JON E

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,088

Applicant(s)

HERZOG, HERBERT

Examiner

J. Eric Angell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

Claims 1-25 are pending in the application.

#### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, drawn to a polynucleotide encoding a polypeptide having an N-terminal amino acid sequence of SEQ ID No. 1 and corresponding to any one SEQ ID No. 2-4 (see below), a vector, and a cell comprising the vector.

Group II, claim(s) 15-19, drawn to an NPY-Y7 receptor having an N-terminal amino acid sequence of SEQ ID No. 1 and corresponding to any one SEQ ID No. 2-4 (see below).

Group III, claim(s) 20, drawn to an antibody.

Group IV, claim(s) 22, drawn to a method for identifying an agonist or antagonist of the NPY-Y7 receptor.

Group V, claim(s) 21, drawn to a transgenic non-human animal.

Group VI, claim(s) 23, drawn to an oligonucleotide or polynucleotide probe.

Group VII, claim(s) 24, drawn to an antisense oligonucleotide.

Group VIII, claim(s) 25, drawn to a method for making an NPY-Y7 receptor.

2. The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the claims encompass a polynucleotide encoding an NPY-Y7 receptor **or a functionally equivalent fragment thereof**. The neuropeptide receptor family was known in the prior art as mentioned in the international search report for the instant application (Blomqvist et al.). Blomqvist et al. teaches a number of neuropeptide receptors (hY1-hY6) that share common sequences and are functional equivalents (fig. 1). Although the NPY-Y7 receptor was not known in the prior art, given the broadest reasonable interpretation of

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claim 1, any of the receptors taught by Blomqvist are functional equivalents of NPY-Y7. Therefore, there is no special technical feature linking the Inventions.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The following claim(s) are generic: 1-25.

The species of polynucleotides sequence are as follows:

- i) A polynucleotide encoding an amino acid sequence corresponding to SEQ ID No. 2.
- ii) A polynucleotide encoding an amino acid sequence corresponding to SEQ ID No. 3.
- iii) A polynucleotide encoding an amino acid sequence corresponding to SEQ ID No. 4.

The species of polypeptides are as follows:

- i) An amino acid sequence corresponding to SEQ ID No. 2.
- ii) An amino acid sequence corresponding to SEQ ID No. 3.
- iii) An amino acid sequence corresponding to SEQ ID No. 4.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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4. The claims are deemed to correspond to the species listed above in the following manner: the species are different polynucleotides and polypeptides claimed in the instant application.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the polypeptides and polynucleotides are chemically different structures with distinct sequences. Given the teaching by Blomqvist et al. that NPY receptors are functionally equivalent, there is no special technical feature linking the species of distinct polypeptides or linking the distinct species of polynucleotides.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is (703) 605-1165. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

J. Eric Angell, Ph.D.  
March 19, 2002

  
**JEFFREY FREDMAN**  
**PRIMARY EXAMINER**